

Claims 1-47 stand provisionally rejected under 35 U.S.C. § 102(e) as being anticipated by published patent application 2002/0135781 (Singh).

The invention, as set forth in independent claims 1, 11, 19, 27, 32, 40, 41, and 45-47, includes the general feature of illuminating a test structure comprising a plurality of intersecting lines that define a grid having openings and determining a dimension of the grid based on measurements of light reflected from the grid. Claim 42 is directed to the test structure comprising a plurality of intersecting lines that define a grid.

The Office Action asserts that Singh teaches these features. To the contrary, Singh is completely silent regarding a test structure comprising a plurality of intersecting lines that define a grid. The passage cited by the Office Action regarding this feature on page 1, paragraph 0002 only generally mentions features such as lines, contact holes, and other features. Nowhere does Singh remotely suggest the test structure set forth in Applicants' claims. An anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990). "[I]t is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990).

Moreover, Singh does not inherently teach Applicants' test structure. The specific test structures disclosed by Singh in Figure 2A do not comprise grid structures, so it does not necessarily follow that Singh would use such a structure. Inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Levy*, 17 U.S.P.Q.2d (BNA) at 1463-64; *Skinner*, at 1789; *In re King*, 231 U.S.P.Q. (BNA) 136, 138 (Fed. Cir. 1986). It is not enough that a reference could

have, should have, or would have been used as the claimed invention. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Oelrich*, at 326, quoting *Hansgird v. Kemmer*, 40 U.S.P.Q. (BNA) 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; *see also Skinner*, at 1789. "Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987), citing *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981).

Accordingly, claims 1-47 are allowable over Singh. Applicants respectfully request the rejection of these claims be withdrawn.


In view of the remarks set forth herein, the application is believed to be in condition for allowance and notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to contact the undersigned attorney at (608) 833-0748 with any questions, comments or suggestions relating to the referenced patent application.

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Respectfully submitted,

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